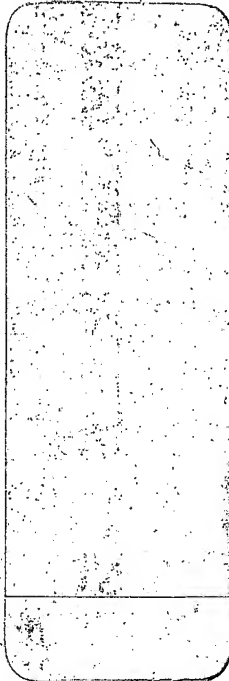


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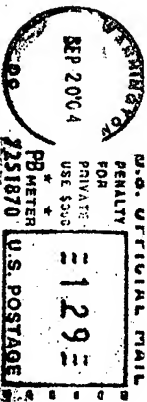
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/035,620	12/28/2001	Durga P. Satapathy	1474	3860

7590 09/20/2004

Harley R. Ball  
Sprint Law Department  
Mailstop: MOKCMP0503  
8140 Ward Parkway  
Kansas City, MO 64114

EXAMINER

BEAMER, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 09/20/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED  
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Technology Center 2600

# Office Action Summary

Application No.

10/035,620

Applicant(s)

SATAPATHY ET AL.

Examiner

Temica M. Davis

Art Unit

2681

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6, 13-21, 23, 24, 26-37, 39, 41-50, 56-61, 63, 64 and 66-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Gorman, U.S. Patent No. 6,141,356.

Regarding claims 1 and 48, Gorman discloses a system/method for multiple access comprising a wireline switch configured to communicate using a wireline communication (col. 2, lines 45-49); a wireless switch (inherent to cellular/wireless systems) configured to communicate using a wireless communication (col. 7, line 45- col. 8, line 4); and an access device (62) configured to communicate with the wireline switch and the wireless switch (col. 6, lines 6-23 and col. 8, lines 35-56; figure 3).

Regarding claims 2 and 49, Gorman discloses the system/method of claims 1 and 48 wherein the access device is configured to receive the wireless communication from the wireless switch and to receive the wireline communication from the wireline switch (col. 6, lines 9-22 and col. 8, lines 35-56).

Regarding claims 3 and 50, Gorman discloses the system/method of claims 1 and 48 wherein the access device is configured to transmit the wireless communication

to the wireless switch and to transmit the wireline communication to the wireline switch (col. 6, lines 9-22 and col. 8, lines 35-56).

Regarding claim 4, Gorman discloses the system of claim 1 wherein the wireless communication comprises at least one member of a group comprising a multipoint multichannel distribution service spectrum communication, a code division multiplex access communication, a personal communication service communication, an unlicensed personal communications services spectrum communication, an industrial scientific medical spectrum communication, an unlicensed national information infrastructure spectrum communication, and a satellite service communication (col. 7, lines 1-9 and col. 7, line 45-col. 8, line 4).

Regarding claim 5, Gorman discloses the system of claim 1 wherein the wireline communication comprises at least one member of a group comprising a digital subscriber line based communication and a hybrid fiber coaxial based communication (col. 3, lines 24-36).

Regarding claim 6, Gorman discloses the system of claim 1 wherein the access device and the wireless switch are not within line of sight (figure 3).

Regarding claim 13, Gorman discloses the system of claim 1 wherein the access device comprises a digital subscriber line modem (col. 8, lines 38-56).

Regarding claim 14, Gorman discloses the system of claim 1 wherein the wireline switch comprises a digital subscriber line access multiplexer (col. 3, lines 33-45).

Regarding claim 15, Gorman discloses the system of claim 1 wherein the wireline switch comprises at least one member of a group comprising a local exchange carrier switch and an interexchange carrier switch (col. 2, lines 40-50).

Regarding claims 16 and 56, Gorman discloses the system/method of claims 1 and 48 wherein the access device is configured to process the wireless communication with at least one member of a group comprising encryption, de-encryption, encoding, decoding, multiplexing, de-multiplexing, modulation, and demodulation (col. 6, lines 9-23).

Regarding claims 17 and 57, Gorman discloses the system/method of claims 1 and 48 wherein the access device is configured to process the wireline communication with at least one member of a group comprising encryption, de-encryption, encoding, decoding, multiplexing, de-multiplexing, modulation, and demodulation (col. 8, lines 38-41).

Regarding claims 18 and 58, Gorman discloses the system of claims 1 and 48 wherein the wireless switch is configured to process the wireless communication with at least one member of a group comprising encryption, de-encryption, encoding, decoding, multiplexing, de-multiplexing, modulation, and demodulation (col. 7, line 45-col. 8, line 4).

Regarding claims 19 and 59, Gorman discloses the system/method of claims 1 and 48 wherein the wireline switch is configured to process the wireline communication with at least one member of a group comprising encryption, de-encryption, encoding,

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decoding, multiplexing, de-multiplexing, modulation, and demodulation (col. 2, lines 40-50).

Regarding claims 20 and 60, Gorman discloses the system/method of claims 1 and 48 further comprising a service node configured to communicate with the wireless switch (col. 7, lines 45-52).

Regarding claims 21 and 61, Gorman discloses the system/method of claims 20 and 60 wherein the service node is configured to communicate with the wireless switch using at least one member of a group comprising a wireless communication and a wireline communication (col. 7, lines 45-52).

Regarding claims 23 and 63, Gorman discloses the system/method of claims 1 and 48 further comprising a service node configured to communicate with the wireline switch (col. 4, lines 20-23).

Regarding claims 24 and 64, Gorman discloses the system/method of claims 23 and 63 wherein the service node is configured to communicate with the wireline switch using at least one member of a group comprising a wireless communication and a wireline communication (col. 4, lines 20-23).

Regarding claims 26 and 66, Gorman discloses the system/method of claims 1 and 48 wherein the wireless communication comprises a first service type communication and the wireline communication comprises a second service type communication (col. 2, line 58-col. 3, line 46).

Regarding claim 27, Gorman discloses a system for multiple access comprising: a wireline switch configured to receive a first set of communications, to format the first

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set of communications as at least one wireline communication, and to transmit the at least one wireline communication (col. 2, lines 45-49); a wireless switch configured to receive a second set of communications, to format the second set of communications as at least one wireless communication, and to transmit the at least one wireless communication (col. 7, line 45-col. 8, line 4); and an access device configured to receive the at least one wireline communication and the at least one wireless communication (col. 8, lines 35-56).

Regarding claim 28, Gorman discloses the system of claim 27 wherein the first set of communications are formatted as a plurality of wireline communications, and the wireline switch is configured to transmit the plurality of wireline communications to the access device (col. 3, lines 24-36).

Regarding claim 29, Gorman discloses the system of claim 27 wherein the wireline switch comprises a digital subscriber line access multiplexer, and the digital subscriber line access multiplexer is configured to multiplex the first set of communications as at least one digital subscriber line wireline communication (col. 3, lines 24-36).

Regarding claim 30, Gorman discloses the system of claim 27 wherein the second set of communications are formatted as a plurality of wireless communications, and the wireless switch is configured to transmit the plurality of wireless communications to the access device (col. 7, line 45-col. 8, line 4).

Regarding claim 31, Gorman discloses the system of claim 27 further comprising a premises equipment wherein the access device is configured to format the wireless



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communication to a digital communication and to transmit the digital communication to the premises equipment (col. 3, lines 16-45; figure 3).

Regarding claim 32, Gorman discloses the system of claim 31 wherein the digital communication comprises voice based data, and the premises equipment is configured to format the digital communication as an analog communication for voice access (col. 3, lines 16-45).

Regarding claim 33, Gorman discloses the system of claim 27 further comprising a premises equipment wherein the wireless communication comprises voice-based data, and the access device is configured to format the wireless communication to an analog communication for voice access and to transmit the analog communication to the premises equipment (col. 3, lines 16-45).

Regarding claim 34, Gorman discloses the system of claim 27 wherein the first set of communications comprises data representative of at least one member of a group comprising voice-based data, internet protocol data, digital data, video data, and media data (col. 8, lines 13-33).

Regarding claim 35, Gorman discloses the system of claim 27 wherein the second set of communications comprises data representative of at least one member of a group comprising voice-based data, internet protocol data, digital data, video data, and media data (col. 8, lines 13-23).

Regarding claim 36, Gorman discloses a system for multiple access comprising: an access transceiver configured to communicate using a wireline communication and a wireless communication (col. 6, lines 6-23 and col. 8, lines 35-56; figure 3); a medium

access control layer configured to control access to the access transceiver for communicating the wireline communication and the wireless communication (figure 3); and a service hub configured to communicate first data for the wireline communication and second data for the wireless communication for at least one premises communication (col. 4, line 47-col. 5, line 43)..

Regarding claim 37, Gorman discloses the system of claim 36 further comprising a multiplexer configured to demultiplex the wireline communication and the wireless communication (col. 3, lines 33-46).

Regarding claim 39, Gorman discloses the system of claim 36 further comprising a multiplexer configured to multiplex at least one member of a group comprising the first data and the second data (col. 3, lines 33-46).

Regarding claim 41, Gorman discloses the system of claim 36 further comprising a modulator configured to modulate data from the premises communication for generation of at least one member of a group comprising the wireline communication and the wireless communication (col. 6, lines 6-23 and col. 8, lines 35-56).

Regarding claim 42, Gorman discloses the system of claim 36 further comprising a modulator configured to demodulate data from at least one member of a group comprising the wireline communication and the wireless communication for generation of the premises communication (col. 6, lines 6-23 and col. 8, lines s35-56).

Regarding claim 43, Gorman discloses the system of claim 36 wherein the access transceiver comprises at least one member of a group comprising a plain old

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telephone service port, a digital subscriber line port, a hybrid fiber coaxial port, and an antenna (col. 3, lines 16-45).

Regarding claim 44, Gorman discloses the system of claim 36 further comprising a premises equipment comprising at least one member of a group comprising a computer, a telephone, a set top box, and a narrowband device (col. 8, lines 35-56; figure 3).

Regarding claim 45, Gorman discloses the system of claim 36 wherein the access transceiver is configured to transmit or receive the wireline communication and the wireless communication (col. 6, lines 6-23 and col. 8, lines 35-56; figure 3).

Regarding claim 46, Gorman discloses the system of claim 36 wherein the medium access control layer further is configured to control a resource for combining first data from the wireline communication and second data from the wireless communication to another communication (col. 5, lines 8-42).

Regarding claim 47, Gorman discloses the system of claim 36 wherein the service hub is configured to transmit or receive the premises communication (col. 4, line 47-col. 5, line 42; figure 3).

Regarding claim 67, Gorman discloses a method for multiple access comprising: receiving a first set of communications at a wireline switch, formatting the first set of communications as at least one wireline communication, and transmitting the at least one wireline communication (col. 2, lines 45-49); receiving a second set of communications at a wireless switch, formatting the second set of communications as at least one wireless communication, and transmitting the at least one wireless

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communication (col. 7, line 45-col. 8, line 4); and receiving the at least one wireline communication and the at least one wireless communication at an access device (col. 6, lines 6-23 and col. 8, lines 35-56).

Regarding claim 68, Gorman discloses the method of claim 67 further comprising formatting the first set of communications as a plurality of wireline communications, and transmitting the plurality of wireline communications to the access device (col. 3, lines 33-46 and col. 8, lines 35-56).

Regarding claim 69, Gorman discloses the method of claim 67 further comprising formatting the second set of communications as a plurality of wireless communications, and transmitting the plurality of wireless communications to the access device (col. 6, lines 6-23).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-12, 22, 25, 38, 40, 51-55, 62 and 65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gorman in view of well known prior art.

Regarding claim 7, Gorman discloses the system of claim 1 wherein the access device is configured to process at least one member of a group comprising the wireless

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communication and the wireline communication using a multiplex asynchronous transfer mode protocol (col. 9, lines 2-7).

Gorman , however, fails to specifically disclose using inverse multiplex ATM. The examiner contends, however, that such a protocol is well known and widely used in the industry, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Gorman with the teachings of well known prior art since such a protocol is used for processing signals. Further, the examiner believes that such a limitation would not render the claims patentable over the applied reference because such a limitation depends merely on how one would like to process the signals.

Regarding claims 8 and 51, Gorman, as modified, discloses the system/method of claims 7 and 48 wherein the processing using inverse multiplex asynchronous transfer mode protocol comprises at least one member of a group comprising multiplexing and de-multiplexing (col. 9, lines 2-7).

Regarding claims 9 and 52, Gorman, as modified, discloses the system of claims 1 and 48 wherein the access device further is configured to receive the wireless communication, to receive the wireline communication, and to use a multiplex asynchronous transfer mode protocol to combine data from the wireless communication and other data from the wireline communication to form a premises communication (col. 5, lines 8-42 and col. 9, lines 2-7).

Gorman , however, fails to specifically disclose using inverse multiplex ATM. The examiner contends, however, that such a protocol is well known and widely used in the industry, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Gorman with the teachings of well known prior art since such a protocol is used for processing signals. Further, the examiner believes that such a limitation would not render the claims patentable over the applied reference because such a limitation depends merely on how one would like to process the signals.

Regarding claims 10 and 53, Gorman, as modified discloses the system/method of claims 9 and 52 further comprising a premises equipment configured to receive the premises communication from the access device (figure 3).

Regarding claims 11 and 54, Gorman discloses the system/method of claims 1 and 48 wherein the access device is configured to use a multiplex asynchronous transfer mode protocol to process a first portion of data for transmission in the wireless communication and to process a second portion of data for transmission in the wireline communication (col. 2, line 58-col. 3, line 46 and col. 9, lines 2-7).

Gorman , however, fails to specifically disclose using inverse multiplex ATM. The examiner contends, however, that such a protocol is well known and widely used in the industry, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Gorman with the teachings of well known prior art since such a protocol is used for processing signals. Further, the examiner believes that

such a limitation would not render the claims patentable over the applied reference because such a limitation depends merely on how one would like to process the signals.

Regarding claims 12 and 55, Gorman discloses the system/method of claims 11 and 54 further comprising a premises equipment configured to transmit a premises communication to the access device, the premises communication comprising the first portion of data and the second portion of data (figure 3).

Regarding claims 22, 25, 62 and 65 Gorman discloses the system/method of claims 20, 23, 61 and 63 as described above wherein the service node is configured to use multiplex asynchronous transfer mode protocol to process a portion of data for transmission to the wireless/wireline switch (col. 7, lines 45-52, col. 8, lines 35-56 and col. 9, lines 2-7).

Gorman , however, fails to specifically disclose using inverse multiplex ATM. The examiner contends, however, that such a protocol is well known and widely used in the industry, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Gorman with the teachings of well known prior art since such a protocol is used for processing signals. Further, the examiner believes that such a limitation would not render the claims patentable over the applied reference because such a limitation depends merely on how one would like to process the signals.

Regarding claims 38 and 40, Gorman discloses the system of claims 37 and 39 wherein the multiplexer is configured to process the wireline communication/first data and the wireless communication/second data with a multiplex asynchronous transfer

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mode protocol to generate another communication (col. 3, lines 33-46 and col. 9, lines 2-7).

Gorman , however, fails to specifically disclose using inverse multiplex ATM. The examiner contends, however, that such a protocol is well known and widely used in the industry, and the examiner takes official notice as such.

Therefore, at the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Gorman with the teachings of well known prior art since such a protocol is used for processing signals. Further, the examiner believes that such a limitation would not render the claims patentable over the applied reference because such a limitation depends merely on how one would like to process the signals.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Adams et al, U.S. Patent No. 6,427,071.

Katko, U.S. Patent No. 6,223,054.

Gillespie, U.S. Patent No. 6,014,377.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached on Monday-Thursday (alternate Fridays) 8:00am-5:00pm.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis  
Examiner  
Art Unit 2681

September 3, 2004

A handwritten signature in black ink, appearing to read "Temica M. Davis", with a horizontal line extending to the right.

<b>Notice of References Cited</b>	Application/Control No. 10/035,620	Applicant(s)/Patent Under Reexamination SATAPATHY ET AL.	
	Examiner Temica M. Davis	Art Unit 2681	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	A	US-6,141,356	10-2000	Gorman, Michael George	370/493
	B	US-6,014,377	01-2000	Gillespie, Donald E.	370/351
	C	US-6,427,071	07-2002	Adams et al.	455/403
	D	US-6,223,054	04-2001	Katko, Mark G.	455/554.2
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
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**FOREIGN PATENT DOCUMENTS**

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**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
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\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

# USPTO TO PROVIDE ELECTRONIC ACCESS TO CITED U.S. PATENT REFERENCES WITH OFFICE ACTIONS AND CEASE SUPPLYING PAPER COPIES

In support of its 21<sup>st</sup> Century Strategic Plan goal of increased patent e-Government, beginning in June 2004, the United States Patent and Trademark Office (Office or USPTO) will begin the phase-in of its E-Patent Reference program and hence will: (1) **provide downloading capability of the U.S. patents and U.S. patent application publications cited in Office actions** via the E-Patent Reference feature of the Office's Patent Application Information Retrieval (PAIR) system; and (2) **cease mailing paper copies of U.S. patents and U.S. patent application publications with Office actions** (in applications and during reexamination proceedings) except for citations made during the international stage of an international application under the Patent Cooperation Treaty (PCT). In order to use the new E-Patent Reference feature applicants must: (1) obtain a digital certificate and software from the Office; (2) obtain a customer number from the Office; and (3) properly associate patent applications with the customer number. Alternatively, copies of all U.S. patents and patent application publications can be accessed without a digital certificate from the USPTO web site, from the USPTO Office of Public Records, and from commercial sources. The Office will continue the practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of cited references will continue to be provided by the USPTO for international applications during the international stage.

## Schedule

June 2004	TCs 1600, 1700, 2800 and 2900
July 2004	TCs 3600 and 3700
August 2004	TCs 2100 and 2600

All U.S. patents and U.S. patent application publications are available on the USPTO web site. However, a simple system for downloading the cited U.S. patents and patent application publications has been established for applicants, called the E-Patent Reference system. As E-Patent Reference and Private PAIR require participating applicants to have a customer number, retrieval software and a digital certificate, all applicants are strongly encouraged to contact the Patent Electronic Business Center to acquire these items. To be ready to use this system by June 1, 2004, contact the Patent EBC as soon as possible by phone at 866-217-9197 (toll-free), 703-305-3028 or 703-308-6845 or electronically via the Internet at [ebc@uspto.gov](mailto:ebc@uspto.gov).

## **Other Options**

The E-Patent Reference function requires the applicant to use the secure Private PAIR system, which establishes confidential communications with the applicant. Applicants using this facility must receive a digital certificate, as described above. Other options for obtaining patents which do not require the digital certificate include the USPTO's free Patents on the Web program (<http://www.uspto.gov/patft/index.html>). The USPTO's Office of Public Records also supplies copies of patents for a fee (<http://ebiz1.uspto.gov/oems25p/index.html>). Commercial sources also provide U.S. patents and patent application publications.

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### **Summary**

The United States Patent and Trademark Office (Office or USPTO) plans in the near future to: (1) cease mailing copies of U.S. patents and U.S. patent application publications (US patent references) with Office actions except for citations made during the international stage of an international application under the Patent Cooperation Treaty and those made during reexamination proceedings; and (2) provide electronic access to, with convenient downloading capability of, the US patent references cited in an Office action via the Office's private Patent Application Information Retrieval (PAIR) system which has a new feature called "E-Patent Reference." Before ceasing to provide copies of U.S. patent references with Office actions, the Office shall test the feasibility of the E-Patent Reference feature by conducting a two-month pilot project starting with Office actions mailed after December 1, 2003. The Office shall evaluate the pilot project and publish the results in a notice which will be posted on the Office's web site ([www.USPTO.gov](http://www.USPTO.gov)) and in the Patent Official Gazette (O.G.). In order to use the new E-Patent Reference feature during the pilot period, or when the Office ceases to send copies of U.S. patent references with Office actions, the applicant must: (1) obtain a digital certificate from the Office; (2) obtain a customer number from the Office, and (3) properly associate applications with the customer number. The pilot project does not involve or affect the current Office practice of supplying paper copies of foreign patent documents and non-patent literature with Office actions. Paper copies of references will continue to be provided by the USPTO for searches and written opinions prepared by the USPTO for international applications during the international stage and for reexamination proceedings.

### **Description of Pilot Project to Provide Electronic Access to Cited U.S. Patent References**

On December 1, 2003, the Office will make available a new feature, E-Patent Reference, in the Office's private PAIR system, to allow more convenient downloading of U.S. patents and U.S. patent application publications. The new feature will allow an authorized user of private PAIR to download some or all of the U.S. patents and U.S. patent application publications cited by an examiner on form PTO-892 in Office actions, as well as U.S. patents and U.S. patent application publications submitted by applicants on form PTO/SB08 (1449) as part of an IDS. The retrieval of some or all of the documents may be performed in one downloading step with the documents encoded as Adobe Portable Document format (.pdf) files, which is an improvement over the current page-by-page retrieval capability from other USPTO systems.

## Steps to Use the New E-Patent Reference Feature During the Pilot Project and Thereafter

Access to private PAIR is required to utilize E-Patent Reference. If you don't already have access to private PAIR, the Office urges practitioners, and applicants not represented by a practitioner, to take advantage of the transition period to obtain a no-cost USPTO Public Key Infrastructure (PKI) digital certificate, obtain a USPTO customer number, associate all of their pending and new application filings with their customer number, install no-cost software (supplied by the Office) required to access private PAIR and E-Patent Reference feature, and make appropriate arrangements for Internet access. The full instructions for obtaining a PKI digital certificate are available at the Office's Electronic Business Center (EBC) web page at: <http://www.uspto.gov/ebc/downloads.html>. Note that a notarized signature will be required to obtain a digital certificate.

To get a Customer Number, download and complete the Customer Number Request form, PTO-SB125, at: <http://www.uspto.gov/web/forms/sb0125.pdf>. The completed form can then be transmitted by facsimile to the Electronic Business Center at (703) 308-2840, or mailed to the address on the form. If you are a registered attorney or patent agent, then your registration number must be associated with your customer number. This is accomplished by adding your registration number to the Customer Number Request form. A description of associating a customer number with an application is described at the EBC web page at: [http://www.uspto.gov/ebc/registration\\_pair.html](http://www.uspto.gov/ebc/registration_pair.html).

The E-Patent Reference feature will be accessed using a new button on the private PAIR screen. Ordinarily all of the cited U.S. patent and U.S. patent application publication references will be available over the Internet using the Office's new E-Patent Reference feature. The size of the references to be downloaded will be displayed by E-Patent Reference so the download time can be estimated. Applicants and registered practitioners can select to download all of the references or any combination of cited references. Selected references will be downloaded as complete documents as Adobe Portable Document Format (.pdf) files. For a limited period of time, the USPTO will include a copy of this notice with Office actions to encourage applicants to use this new feature and, if needed, to take the steps outlined above in order to be able to utilize this new feature during the pilot and thereafter.

During the two-month pilot, the Office will evaluate the stability and capacity of the E-Patent Reference feature to reliably provide electronic access to cited U.S. patent and U.S. patent application publication references. While copies of U.S. patent and U.S. patent application publication references cited by examiners will continue to be mailed with Office actions during the pilot project, applicants are encouraged to use the private PAIR and the E-Patent Reference feature to electronically access and download cited U.S. patent and U.S. patent application publication references so the Office will be able to objectively evaluate its performance. The public is encouraged to submit comments to the Office on the usability and performance of the E-Patent Reference feature during the pilot. Further, during the pilot period registered practitioners, and applicants not represented by a practitioner, are encouraged to experiment with the feature, develop a proficiency in using the feature, and establish new internal processes for using the new access to the cited U.S. patents and U.S. patent application publications to prepare for the anticipated cessation of the current Office practice of supplying copies of such cited

references. The Office plans to continue to provide access to the E-Patent Reference feature during its evaluation of the pilot.

### Comments

Comments concerning the E-Patent Reference feature should be in writing and directed to the Electronic Business Center (EBC) at the USPTO by electronic mail at [eReference@uspto.gov](mailto:eReference@uspto.gov) or by facsimile to (703) 308-2840. Comments will be posted and made available for public inspection. To ensure that comments are considered in the evaluation of the pilot project, comments should be submitted in writing by January 15, 2004.

Comments with respect to specific applications should be sent to the Technology Centers' customer service centers. Comments concerning digital certificates, customer numbers, and associating customer numbers with applications should be sent to the Electronic Business Center (EBC) at the USPTO by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

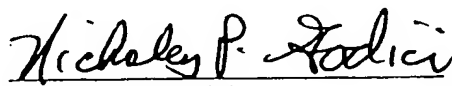
### Implementation after Pilot

After the pilot, its evaluation, and publication of a subsequent notice as indicated above, the Office expects to implement its plan to cease mailing paper copies of U.S. patent references cited during examination of non provisional applications on or after February 2, 2004; although copies of cited foreign patent documents, as well as non-patent literature, will still be mailed to the applicant until such time as substantially all applications have been scanned into IFW.

### For Further Information Contact

Technical information on the operation of the IFW system can be found on the USPTO website at <http://www.uspto.gov/web/patents/ifw/index.html>. Comments concerning the E-Patent Reference feature and questions concerning the operation of the PAIR system should be directed to the EBC at the USPTO at (866) 217-9197. The EBC may also be contacted by facsimile at (703) 308-2840 or by e-mail at [EBC@uspto.gov](mailto:EBC@uspto.gov).

Date, 12/1/03



Nicholas P. Godici  
Commissioner for Patents